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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,722	04/16/2004	Russell F. McKnight	ACER-45262	1771
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EXAMINER				
UBER, NATHAN C				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/826,722

Applicant(s)

MCKNIGHT ET AL.

Examiner

NATHAN C. UBER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 10-12 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 10-12 and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on 10 March 2009.
2. Claims 1 and 10 have been amended.
3. Claims 19-22 have been added.
4. Claims 13-18 have been canceled.
5. Claims 1, 3 and 10-12 and 19-22 are currently pending and have been examined.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1, 3, 10-12 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett (US 6,473,738 B1) in view of Jacobi et al. (US 7,113,917 B2).

Claim 1:

Garrett, as shown, discloses the following limitations:

- *determining, by the computerized transaction system, if the computerized transaction is associated with the user or on behalf of a third party (see at*

least column 3, lines 50-52, the customer indicates while shopping that an item is intended for a third party),

- *aggregating, by the computerized transaction system, information associated with the transaction in a profile corresponding to the user if the computerized transaction is determined to be associated with the user (see at least column 3, lines 52-53, "saving the selection list"),*
- *aggregating, by the computerized transaction system, the information associated with the transaction in the profile corresponding to the user according to a profile distinction associated with the third party if the computerized transaction is determined to be associated with the third party (see at least column 3, lines 52-53, "saving the selection list"),*

Garrett does not specifically disclose the following additional limitations, but Jacobi, as shown, does:

- *determining an offer tailored to one or more of the user or to the third party based upon either the profile corresponding to the user or the profile distinction associated with the third party (see at least column 6, lines 14-22 provides recommendations based on items in user's list),*
- *presenting, by the computerized transaction system, the offer to the user, wherein the offer comprises one or more of a special offer, a promotion, a product recommendation, and a product suggestion (see at least column 4, lines 55-61, implementing a variety of recommendation services... generates personal recommendations),*
- *the offer, if tailored for the third party, is based upon the profile distinction corresponding to the third party and is not based upon the profile corresponding to the user (see at least column 6, lines 23-37, user designates shopping carts for different people (self, children , etcetera) and recommendations are made based on current shopping cart contents or past*

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shopping cart purchases/selections, but are specific to a particular designated shopping cart),

- *the offer, if tailored to the user, is based upon the profile distinction corresponding to the user and is not based upon the profile distinction associated with the third party* (see at least column 6, lines 23-37, user designates shopping carts for different people (self, children , etcetera) and recommendations are made based on current shopping cart contents or past shopping cart purchases/selections, but are specific to a particular designated shopping cart),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine capacity to differentiate between purchase histories and item selections for various parties within one user's account (the invention of Garrett) with the automated generation of product promotions/recommendations based on shopping cart content and previous purchases (the invention of Jacobi) since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 3:

The combination Garrett/Jacobi discloses the limitations as shown in the rejections above. Further, Garrett, as shown, discloses the following limitations:

- *determining if the profile distinction associated with the third party is already present in the profile* (see at least column 6, line 42, the list of parties can be displayed),
- *establishing the profile distinction associated with the third party if the profile distinction is not already present in the profile* (see at least column 3, lines 46-47, generating... a list of names... the customer may associate items with),

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- *aggregating the information associated with the transaction in the profile distinction associated with the third party if the profile distinction is already present in the profile (see at least column 3, lines 52-53, "saving the selection list").*

Claim 10:

Garrett, as shown, discloses the following limitations:

- *initiating a computerized transaction with the user by the merchant for a subject using the computerized transaction system (see at least column 6, line 16-20, log-on),*
- *receiving, by the computerized transaction system, from the user an indication of whether the subject of the computerized transaction is intended for use by the user or by a third party (see at least column 3, lines 50-52, the customer indicates while shopping that an item is intended for a third party),*
- *distinguishing in the computerized database system between the subject of computerized transactions by the user that is intended for use by the user and the subject of computerized transactions by the user that is intended for use by the third party (see at least column 3, lines 50-52, the customer indicates while shopping that an item is intended for a third party),*
- *aggregating the information associated with the transaction in a profile corresponding to the user if the subject of the computerized transaction is determined to be associated with the user (see at least column 3, lines 52-53, "saving the selection list"),*
- *aggregating the information associated with the transaction in a profile corresponding to the user according to a profile distinction associated with the third party if the subject of the computerized transaction is determined to be associated with the third party (see at least column 3, lines 52-53, "saving the selection list"),*

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Garrett does not specifically disclose the following additional limitations, but Jacobi, as shown, does:

- *determining an offer tailored to one or more of the user or to the third party based upon either the profile corresponding to the user or the profile distinction associated with the third party (see at least column 6, lines 14-22 provides recommendations based on items in user's list),*
- *presenting, by the computerized transaction system, the offer to the user, wherein the offer comprises one or more of a special offer, a promotion, a product recommendation, and a product suggestion (see at least column 4, lines 55-61, implementing a variety of recommendation services... generates personal recommendations),*
- *the offer, if tailored for the third party, is based upon the profile distinction corresponding to the third party and is not based upon the profile corresponding to the user (see at least column 6, lines 23-37, user designates shopping carts for different people (self, children , etcetera) and recommendations are made based on current shopping cart contents or past shopping cart purchases/selections, but are specific to a particular designated shopping cart),*
- *the offer, if tailored to the user, is based upon the profile distinction corresponding to the user and is not based upon the profile distinction associated with the third party (see at least column 6, lines 23-37, user designates shopping carts for different people (self, children , etcetera) and recommendations are made based on current shopping cart contents or past shopping cart purchases/selections, but are specific to a particular designated shopping cart),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine capacity to differentiate between purchase histories and item selections for various parties within one user's account (the invention of Garrett) with the

automated generation of product promotions/recommendations based on shopping cart content and previous purchases (the invention of Jacobi) since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 11:

The combination Garrett/Jacobi discloses the limitations as shown in the rejections above. Further, Garrett, as shown, discloses the following limitations:

- *the presenting the offer to the user is not based upon the information in the user profile regarding the subject of computerized transactions by the user that is intended for use by the third party* (see at least column 7, lines 39-40 shopping list, see also Figure 5, there is no guidance in the specification defining the contents of a user profile, examiner interprets the user profile to be a aggregation of previous purchases designated to the user not to third party recipients, further examiner broadly interprets any listing or products to constitute *an offer*, therefore a list of products organized under products purchased or to be purchased by/for the user anticipates the limitation).

Claim 12:

The combination Garrett/Jacobi discloses the limitations as shown in the rejections above. Further, Garrett, as shown, discloses the following limitations:

- *aggregating, in a user profile for the user in the computerized database system, information regarding the subject of computerized transactions by the user that is intended for use by the user* (see at least column 3, lines 52-53, "saving the selection list"),
- *aggregating, in the user profile for the user in the computerized database system, information regarding the subject of computerized transactions by the user that is intended for use by the third party* (see at least column 3, lines 52-53, "saving the selection list").

Claims 19, 20 and 22:

The combination Garrett/Jacobi discloses the limitations as shown in the rejections above. Garrett does not specifically disclose offers. However, Jacobi, as shown, discloses the following limitation:

- *the determining of an offer is based upon a past purchase transactions and the presented offer is for a future purchase by the user (see at least column 6, line 33-37, uses items that were purchased as basis for offers),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine capacity to differentiate between purchase histories and item selections for various parties within one user's account (the invention of Garrett) with the automated generation of product promotions/recommendations based on shopping cart content and previous purchases (the invention of Jacobi) since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 21:

Garrett, as shown, discloses the following limitations:

- *determining, by the computerized transaction system, if the computerized purchase transaction is associated with the user or if the computerized purchase transaction is associated with the user on behalf of a third party (see at least column 3, lines 50-52, the customer indicates while shopping that an item is intended for a third party),*
- *aggregating, by the computerized transaction system, information associated with the purchase transaction in a profile corresponding to the user if the computerized purchase transaction is determined to be associated with the user (see at least column 3, lines 52-53, "saving the selection list"),*
- *aggregating, by the computerized transaction system, the information associated with the purchase transaction in the profile corresponding to the*

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user according to a profile distinction associated with the third party if the computerized purchase transaction is determined to be associated with the third party (see at least column 3, lines 52-53, "saving the selection list"),

Garrett does not specifically disclose the following additional limitations, but Jacobi, as shown, does:

- *determining an offer tailored to one or more of the user or to the third party based upon either the profile corresponding to the user or the profile distinction associated with the third party (see at least column 6, lines 14-22 provides recommendations based on items in user's list),*
- *presenting, by the computerized transaction system, the offer to the user, wherein the offer comprises one or more of a special offer, a promotion, a product recommendation, and a product suggestion (see at least column 4, lines 55-61, implementing a variety of recommendation services... generates personal recommendations),*
- *the offer, if tailored for the third party, is based upon the profile distinction corresponding to the third party and is not based upon the profile corresponding to the user (see at least column 6, lines 23-37, user designates shopping carts for different people (self, children , etcetera) and recommendations are made based on current shopping cart contents or past shopping cart purchases/selections, but are specific to a particular designated shopping cart),*
- *the offer, if tailored to the user, is based upon the profile distinction corresponding to the user and is not based upon the profile distinction associated with the third party (see at least column 6, lines 23-37, user designates shopping carts for different people (self, children , etcetera) and recommendations are made based on current shopping cart contents or past shopping cart purchases/selections, but are specific to a particular designated shopping cart),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine capacity to differentiate between purchase histories and item selections for various parties within one user's account (the invention of Garrett) with the automated generation of product promotions/recommendations based on shopping cart content and previous purchases (the invention of Jacobi) since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Response to Arguments

9. Applicant's arguments filed 10 March 2009 have been fully considered but they are not persuasive. Applicant argues on page 8 of Applicant's remarks that Jacobi does not disclose providing offers based on the individual profiles and Applicant attempts to elaborate on this alleged distinction in the claims with Applicant's amendments to the independent claims which explicitly states that offers are based on one profile and not the other. However, Examiner disagrees that Jacobi does not disclose offers based on a single profile, as noted in the rejection above, Jacobi discloses a distinction capability among shopping carts that is analogous to the distinctions among profiles in Garrett and the Applicant's application. Further Jacobi discloses in at least column 6, lines 23-37 generating recommendations based on either the current contents of a specific shopping cart or previous contents that were purchased from the specific shopping cart. Jacobi further notes in column 6, line 38-42, that the same techniques for generating recommendations based on shopping cart contents can also be incorporated into other recommendation systems. Examiner determined that the recommendation features may be combined with the Garrett reference which discloses profile distinctions as show in the rejection above. Therefore Applicant's claim limitations which are both directed to generating offers and to profile distinctions are taught by a combination of teachings from the Jacobi and Garrett references. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

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combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

10. Applicant argues on page 10 that Jacobi does not disclose the "presenting... the offer..." limitations of the claims because the Jacobi reference does not specifically disclose that the offer presented is based on profile distinctions. Essentially Applicant again is arguing, as noted above, the references individually when the rejection is based on a combination of references. The rejection indicates that Garrett is relied on to teach the profile distinction limitations, further that Jacobi's analogous distinction ability between shopping carts, allowing for specialized recommendations among the differentiated shopping carts, may be applied by one having ordinary skill in the art at the time of the invention to the profiles of Garrett. This combination teaches the limitations of generating offers based on profile distinctions, and further, as shown by Jacobi's disclosure of actually presenting the generated offers to a user, the combination further teaches the claim limitation of presenting the offers to the user.

Conclusion

11. The prior art rejections are maintained in this action. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
12. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
13. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on

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Monday-Friday, 8:30am-4:00pm EST. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

15. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450, Alexandria, VA 22313-1450

or faxed to **571-273-8300**.

16. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building
401 Dulany Street
Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 3622
6 July 2009

/Eric W. Stamber/
Supervisory Patent Examiner, Art Unit 3622